



**UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/349,177	12/02/94	GREY	H 14137-58-4

020350
TOWNSEND AND TOWNSEND AND CREW
TWO EMBARCADERO CENTER EIGHTH FLOOR
SAN FRANCISCO CA 94111

HM31/0511

EXAMINER	
SCHWADRON, R	
ART UNIT	PAPER NUMBER
1644	

DATE MAILED: 05/11/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/349,177

Applicant(s)

Grey et al.

Examiner

Ron Schwadron, Ph.D.

Group Art Unit

1644



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 19-55 is/are pending in the application.

Of the above, claim(s) 19-36 and 48-55 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 37-47 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

15. Newly submitted claims 19-36 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Original claims 1-10 (and newly added claims 37-55) are drawn to a composition, classified in Class 530, subclass 350 and Class 514, subclass 15. Claims 19-36 are drawn to a method of inducing a CTL response in a patient, classified in Class 435, subclass 2 and Class 424, subclass 184.1. The inventions of claims 37-55 and 19-36 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used to stimulate T cell responses from normal individuals (eg. nonpatients).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. **Accordingly, claims 19-36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.**

Regarding applicants comments in page 6 of the instant amendment, the M.P.E.P. § 803 (Rev. 3, July 1997, page 800-4) states that: "For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search". The restriction requirement enunciated in this Office Action meets this criterion and therefore establishes that serious burden is placed on the Examiner by the searching of additional Groups.

16. Claims 48-55 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species (as per the election of species requirement enunciated in the Office Action mailed 2/6/96 and Office Action mailed 12/23/96), the requirement having been traversed in Paper No. 5 and 7. Claim 37 is included in the elected group only in so far as it reads on the elected peptide of nine residues.

17. Claims 37-47 are under consideration.

18. This application contains claims directed to the following patentably distinct species of the

claimed invention.

Claims 37-47 are generic to a plurality of disclosed patentably distinct species comprising 9-mer peptides wherein the species is any particular set of peptides which is encompassed by a particular formula recited in the claims. Such species would be a peptide with a first conserved residue at the second position from the N-terminus where the amino acid was A and a second conserved residue at the C-terminal wherein the amino acid was M (eg. the composition of claim 37 wherein one amino acid from each Markush group recited in the claim is elected). Applicant needs to select one species from claims 37-47 (eg. a peptide with a first conserved residue at the second position from the N-terminus where the amino acid was A and a second conserved residue at the C-terminal wherein the amino acid was M, etc). These peptides are structurally and functionally distinct, and derived from different proteins with different functions.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

19. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

20. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

21. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Supervisory Patent Examiner Christina Chan, at 703-308-3973. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

22. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Dr. Ron Schwadron whose telephone number is (703) 308-4680. The examiner can normally be reached Tuesday through Friday from 8:30 to 6:00. The examiner can also be reached on alternative Mondays. A message may be left on the examiners voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ms Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Group ¹⁶⁰⁰180 receptionist whose telephone number is (703) 308-0196.



RONALD B. SCHWADRON
PRIMARY EXAMINER
GROUP 1800 1600

Ron Schwadron, Ph.D.

Primary Examiner

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May 7, 1998